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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,415	01/30/2004	Philip Emery	7015	6942
7590	07/03/2006		EXAMINER	
Gauthier & Connors, LLP Suite 3300 225 Franklin Street Boston, MA 02110				SHEWAREGED, BETELHEM
		ART UNIT	PAPER NUMBER	1774

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/768,415	EMERY ET AL.	
	Examiner Betelhem Shewareged	Art Unit 1774	

*- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -*  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 20 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 25-46 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/20/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

1. Applicant's response filed on 04/20/2006 has been fully considered. The claim objections, the 35 USC 102 and the 35 USC 103 rejections have been withdrawn in view Applicant's amendments.
2. Claims 1-24 are canceled, claims 25-46 are added, and thus claims 25-46 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-39 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 5,190,609) in view of Ast (US 6,248,427 B1) and Hughen et al. (US 5,747,192).
5. Lin discloses a heat shrinkable label comprising a backing sheet (col. 2, line 42), a first pressure sensitive adhesive (PSA) on the backing layer (col. 2, line 56), a first shrinkable layer on the first PSA (col. 2, line 44), graphics on the first shrinkable layer (col. 3, line 23), a second pressure sensitive adhesive (PSA) on the graphics (col. 3, line 32), and a second shrinkable layer on the second PSA (col. 2, line 44). The shrinking temperature of the first and second shrinkable layers is 240-250 degree F (col. 3, line

56), and the layers are made of polypropylene (col. 2, line 45). The thickness of the shrinkable layer is 1.25 mils (col. 4, line 63). With respect to the claimed stiffness value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Lin reference teaches substantially identical material, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Lin does not teach the use of polystyrene as the shrinkable layers.

6. Ast teaches adhesive label comprising a shrinkable cover foil that can be made of polypropylene, polystyrene, polyethylene or polyester (col. 3, lines 37-42).

7. Lin and Ast are analogous art because they are from the same field of endeavor that is the heat shrinkable label art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use polystyrene to make the shrinkable layers of Lin since the examiner takes Official Notice of the equivalence of polyethylene and polystyrene for there use in the heat shrinkable art and the selection of any of there known equivalents to make the shrinkable layers would be within the level of ordinary skill in the art.

8. With respect to the shrink and growth direction of the label, it is well known in the shrinkable label art for the label to be applied on a battery to shrink up to 60% in the direction normal to the axis of the battery, and to shrink -2 to +5% in the axial direction,

wherein negative shrinkage means elongation. Such characteristics are well known in the art before the claimed invention (see col. 5, lines 19-36 of Hughen).

9. Claims 26, 40-43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ast (US 6,248,427 B1) in view of Lin et al. (US 5,190,609) and Hughen et al. (US 5,747,192).

10. Ast discloses an adhesive shrinkable label comprising a carrier (col. 4, line 17), an adhesive on the carrier (col. 4, line 15), a carrier material on the adhesive (col. 4, lines 7-13), wherein the carrier material comprises metallic layer and non-metallic layer, a laminating adhesive on the carrier material (col. 5, line 52), imprints on the laminating adhesive, and a shrinkable cover foil on the imprint (col. 3, line 39). The shrinkable cover foil comprises polyethylene, however, Ast does not teach the shrinking temperature value of the shrinkable cover foil. The shrinking temperature value would fall within the claimed range because Lin teaches the use of polyethylene as the shrinkable layer and this layer shrinks at a range of 240-250 degree F (col. 3, line 56 of Lin).

11. With respect to the shrink and growth direction of the label, it is well known in the shrinkable label art for the label to be applied on a battery to shrink up to 60% in the direction normal to the axis of the battery, and to shrink -2 to +5% in the axial direction, wherein negative shrinkage means elongation. Such characteristics are well known in the art before the claimed invention (see col. 5, lines 19-36 of Hughen).

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.  
June 28, 2006.



BETELHEM SHEWAREGED  
PRIMARY EXAMINER